

REMARKS

This paper is responsive to an Office Action mailed May 4, 2005. Prior to this amendment claims 1-34 were pending. After amending claims 1, 3, 8-10, and 33, and canceling claim 2, claims 1 and 3-34 remain pending.

The Office Action has rejected claims 1-34 under 35 U.S.C. 103(a) as unpatentable with respect to King (US 6,587,122), Cochran (US 6,345,273), and Black et al. ("Black"; US 6,285,998). The Office Action acknowledges that King only describes help for entering programming instructions, but that it would have been obvious to combine King with Cochran's system, which supplies help in finding search terms. The Office Action states that it would have been obvious to supply "help" in the style of King's entry-responsive pop-up generator in the role of search assistance as seen in Cochran's pop-ups, to allow a sequence of search entries to be coupled to additional input terms.

The Office Action acknowledges that the combination of King and Cochran fails to describe search syntax characters, but states that Black demonstrates a user interface to supply search syntax characters, because Black's "Operator" dialogue is popped onto the screen, "by which "search syntax characters" may then be specified." It would have been obvious to combine Black with King and Cochran because "Operators" are part of a complete query, and would be a useful adjunct to a more comprehensive search. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As

stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

In his Abstract, and in col. 9, ln. 56 through col. 10, ln. 6, King describes a system that displays instruction syntax help as instructions are entered into an editor tool. The process is similar to a function call in a programming language. In this case, the user must enter the function name before the "help" for this function is displayed.

Cochran (Abstract, col. 4, ln. 63 through col. 5, ln. 8) describes a system that dynamically suggests search terms when a user points to a particular category. Suggested search terms appear in a popup window.

Black (Abstract and col. 7, ln. 54-63, Fig. 7) describes a system that permits a user to select an operator column. In response to the selection, a popup field of operators appears, and the user can select an option from the field.

With respect to the first *prima facie* requirement, Office Action says that the motivation to combine King and Cochran comes from Cochran, "where an ongoing search query as involves an entry field would be an advantageous extension to the identically-disclosed search

algorithm that narrows via popped-up terms." However, it is not entirely clear that these references can be combined, even in retrospect. King's popup provides variables for a particular programming command, and Cochran's popup provides search terms. There seems to be no clear relationship between programming command popups and the use of search terms.

Further, the desirability of combining references in retrospect is not a proof of motivation. Even if there is logic to combine the references, the resultant device does not point to the claimed invention. The claimed invention is not a search algorithm, or a means of narrowing a search using popup items.

The Office Action states that it would have been obvious to combine Black with King and Cochran because Black's "Operators" are part of a complete query, and would be a useful adjunct to a more comprehensive search. Again, the issue of motivation does not concern itself with whether there is some element of commonality between references. If it did, then any two references could be combined merely as the result of a keyword search. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion of motivation in the references to do so." *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Here, the analysis must determine if there is any motivation to modify the King and Cochran systems, using Black's user interface in such a manner as to teach the claimed invention.

Black describes an "ask me" wizard that can be manually prompted by the user to supply a popup for a window that is labeled "operators". Specifically, Black describes three series-connected edit

equation (field names, operators, and values). Alternately stated, the

~~"operators" is a separate permanent field, with its own popup window.~~

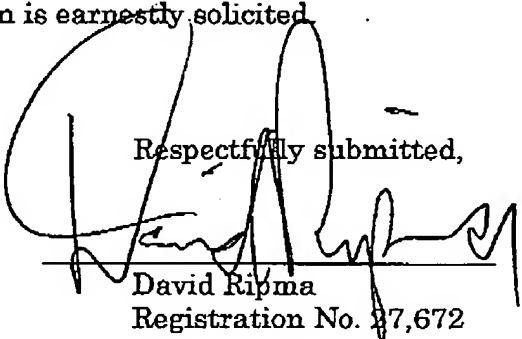
The operators box is not a help window that temporarily pops up to help a user understand or use an associated edit box.

Therefore, the combination of King, Cochran, and Black does not disclose the limitations of displaying a list of supported search syntax characters in response to selecting an edit box (claim 1). Neither does the combination of references describe the limitation of a search syntax popup window that appears in response to selecting an edit box (claim 18). Claims 3-17, dependent from claim 1, and claims 19-34, dependent from claim 18, enjoy the same distinctions from the cited prior art. The Applicant respectfully requests that the rejections be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,


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